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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,584	06/01/2001	Frank W. Sudia	P 264493 AUTH-II	9326

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EXAMINER

KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,584

Applicant(s)

SUDIA ET AL.

Examiner

Paula W. Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 18-21 and 72-108 is/are pending in the application.
- 4a) Of the above claim(s) 85-108 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 18, 20, 21, 72-74, 77-80, 83 and 84 is/are rejected.
- 7) ☐ Claim(s) 19, 75-76, 81-82 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on 07/05/05. Applicant added Claims 72-108, cancelled Claims 2-17 and 22-71. Applicants also have made the appropriate adjustment to Claims 22-71 to overcome the restriction of the previous office action. The amendment filed on 07/05/05 have been entered and made of record.

New claims 85-108 constitute distinguished claimed inventions from the original presentation of claim 1.

Newly submitted claims 85-108 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 85-108 are drawn to a commercial transaction having checking the attribute, checking the rules to determining to allow the transaction, which are classified 705/53. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 85-108 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Applicant's arguments filed 07/05/05 have been fully considered but they are not persuasive because of following reasons.

Applicant argued that Mufti and Curry do not disclose denying access to a public key and in response to a digital signing, permitting a recipient to utilize said public key. This is not found

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persuasive. Mufti discloses a system wherein the public keys and certificates are distributed, and therefore the general public, does not have access to the keys. In additions the request for the certificate, and therefore the public key, is validated and if the request is valid the certificate is issued (column 11 lines 42-53 and column 14 lines 35-42). Further the if the authentication fails a certificate signature reject message is sent and as a result the access to the public key is denied.

In response to applicant's arguments, the recitation “deny access to a certification authority’s public key and in response to a digital signing by the recipient, permits a recipient to utilize that public key” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The examiner will not interpret to read narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the examiner asserts that Mufti and Curry do teach or suggest the subject matter broadly recited in independent Claims 1, 73, and 79. Dependent Claims 18-21, 72, 74-78, and 80-84 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action. Accordingly, rejections for claims 1, 18-21, and 72-84 are respectfully maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 21, 72-73, and 77-78 are rejected under 35 U.S.C. 102(e) as being anticipated by Muftic (US 5,745,574).

Claims 1 and 73: Muftic's patent discloses certifying authority issues digital certificate identifying users of the system in (Fig. 26). Muftic discloses digital certificates being digitally signed with a private key of certifying authority to form a digital signature and requiring a public key of certifying authority in order to verify digital signature in (column 14, lines 54-63). Muftic discloses a user transaction in a cryptographic system requires verification by a recipient of user transaction verification based on information in digital certificates and requiring the public key in (column 10 lines 34-49). Muftic discloses denying access to public key in (column 4 lines 65-67; column 5 lines 1-2). Muftic discloses providing recipient with at least one message

containing the rules of the system including a rule regarding maintaining secrecy of public key in (column 10 lines 52-57). Muftic discloses digitally signing by recipient at least one message which recipient agrees to rules and permitting recipient to utilize public key in (column 11 lines 29-53; column 12 lines 32-40).

Claims 21 and 72: Muftic discloses user transaction is invalid until digital signing is performed in (column 12 lines 22-43).

Claim 77: Muftic discloses user transaction of said recipient in the system is invalid until said digital signing is performed (column 12 lines 30-35).

Claim 78: Muftic discloses responding to said signing by said recipient, a certifying authority accepting a transaction from said recipient, said transaction based on a user transaction of said recipient in the system (column 10 lines 45-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 20, 74, 79-80, and 83-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic (5,745,574) in view of Curry (5,940,510).

Claims 18 and 74: Muftic does not specifically disclose providing recipient with a secure device containing public key, wherein public key cannot be obtained from secure device.

Curry's patent discloses secure device containing public key, wherein public key cannot be

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obtained from secure device (column 4 lines 49-55). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ a secure device containing public key wherein public key cannot be obtained from secure device as taught in Curry with public key storage of Muftic in so that the key can be protected and secured at all times against tampering/malicious attacks thus providing secure means to conduct transactions by the users.

Claim 20: Muftic discloses containing rules of system including a rule regarding maintaining secrecy of public key. Muftic does not include a rule to pay for use by said recipient of intellectual property provided through the system. Curry teaches the monetary value of the recipient is decreased (paying) for use of the system when information is matched (rule, column 7 lines 21-35). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a rule to pay as taught in Curry to the system in Muftic in order to provide recipient's privileges and conveniences for the use of the system.

Claim 79: Muftic's patent discloses certifying authority issues digital certificate identifying users of the system in (Fig. 26). Muftic discloses providing a recipient with a message containing rules of said system (column 10 lines 52-57). This system disclosed by Muftic includes an inactive form of said public key (column 15 lines 32-36 in combination with column 12 lines 60-64). In response to said recipient digitally signing said message, activating said public key in said secure device (column 15 lines 36-43).

Muftic does not specifically disclose providing recipient with a secure device containing public key, wherein public key cannot be obtained from secure device. Curry's patent discloses secure device containing public key, wherein public key cannot be obtained from secure device (column 4 lines 49-55). It would have been obvious to a person of ordinary skill in the art at the

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time the invention was made to employ a secure device containing public key wherein public key cannot be obtained from secure device as taught in Curry with public key storage of Muftic in so that the key can be protected and secured at all times against tampering/malicious attacks thus providing secure means to conduct transactions by the users.

Claim 80: Muftic discloses a public key that is a public key of a certifying authority, said providing is performed by a certifying authority (column 10 lines 35-57), said digitally signing comprises hashing said message to obtain a hashed document, digitally signing said hashed document to form a digital agreement (column 12 lines 54-56), and returning said digital agreement to said certifying authority, and said activating is performed by said certifying authority (column 12 lines 7-21).

Claims 83 and 92: Muftic discloses user transaction of said recipient in the system is invalid until said digital signing is performed (column 12 lines 30-35).

Claims 84 and 93: Muftic discloses responding to said signing by said recipient, a certifying authority accepting a transaction from said recipient, said transaction based on a user transaction of said recipient in the system (column 10 lines 45-57 in combination with column 11 lines 60-65).

Allowable Subject Matter

Claims 19, 75-76, and 81-82 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

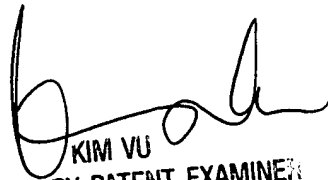
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK

Monday, September 19, 2005



KIM VU
ASSISTANT PATENT EXAMINER
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